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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/518,385	12/29/2004	Roberto Lanfredi	262956USOX PCT	8970
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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER				
LSTVOYB, GREGORY				
ART UNIT		PAPER NUMBER		
1796				
NOTIFICATION DATE		DELIVERY MODE		
09/10/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/518,385

Applicant(s)

LANFREDI ET AL.

Examiner

GREGORY LISTVOYB

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-8,10-21 and 23-26 is/are pending in the application.
- 4a) Of the above claim(s) 15,18 and 19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-8,10-14, 16-17, 20-21 and 23-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3, 5-8, 10-11, 13-14, 16-17, 19-21 rejected under 35 U.S.C. 103

(a) as being unpatentable over Nonweiler (US 3457205) herein Nonweiler in combination with Bardman et al (US 2003/0018103) herein Bardman.

Nonweiler discloses a composition for making coated expanded polystyrene foam.

Nonweiler teaches polystyrene beads consisting of

a) a matrix obtained by polymerizing 100% by weight of polystyrene beads ranging in size between 16 and 40 mesh (Example 1)

b) 5.3% by weight, calculated with respect to the polymer (a), of an expanding agent englobed in the polymeric matrix.

c) 0.2-2% of organic and inorganic pigment (see Column 4, line 5).

Nonweiler does not disclose that inorganic pigment is Iron Oxide.

Bardman disclose a polystyrene beads containing Iron Oxide pigment.
(see line 0042).

According to MPEP 2144.07, the selection of a known material based on its suitability for its intended use supported a *prima facie* obviousness determination in *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327, 65 USPQ 297 (1945) , 325 U.S. at 335, 65 USPQ at 301, see also *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960), *Ryco, Inc. v. Ag-Bag Corp.*, 857 F.2d 1418, 8 USPQ2d 1323 (Fed. Cir. 1988).

Therefore, it would have been obvious to a person of ordinary skills in the art to use Ferric Oxide as an inorganic pigment in Nonweiler, since Ferric Oxide is known material based on its suitability for its intended use.

Claim 12 rejected under 35 U.S.C. 103 (a) as being unpatentable over Nonweiler in combination with Bardman and Harclerode et al (US patent 5240657) herein Harclerode (necessitated by Amendments).

Nonweiler discloses polystyrene beads for making coated expanded polystyrene foam consisting of a polystyrene matrix, expanding agent and an inorganic pigment.

Bardman disclose a polystyrene beads containing Iron Oxide pigment.

Notweiler or Bardman does not teach molecular weight of the polymer within the range of 50000-250000.

Harderode discloses:

a) a matrix obtained by polymerizing 50-100% by weight of one or more vinylaromatic monomers (Example 1) with molecular weight M_w within the range of 200000-220000 (Column 19, line 52) at the presence of suspending agent, initiating agent and expanding agent (Examples 1 and 2),

b) 1-10% by weight, calculated with respect to the polymer (a), of an expanding agent englobed in the polymeric matrix (3.1% g of pentane, Example 2).

The position is taken that polystyrene of the above molecular weight range (i.e. 50000-250000) is a standard polymer in production of polymer beads. It combines sufficient strength with acceptable melt viscosity, which allowing production of beads with good mechanical properties. It also makes possible to use standard processing conditions on widely used commercial equipment.

Therefore, it would have been obvious to a person of ordinary skills in the art to use polystyrene beads with molecular weight within the range of 50000-250000 in order to produce high quality product with good mechanical properties with minimum processing cost.

Claims 1, 3, 5-8, 10-14, 16-17, 19-21 and newly added claims 23-26 rejected under 35 U.S.C. 103 (a) as being unpatentable over Voss et al (US 4772441) herein Voss in combination with Ishigaki et al (US 5354618) (necessitated by Amendments).

Voss teaches styrene polymer 1.2-1.8 mm beads (see Column 4, line 25) consisting of 3-10 % of blowing agent (see Column 1, line 30) and 0.2% of mixture of Zn Stearate and Glycerol monostearate (i.e. ester of C18 fatty acid).

Voss does not teach Fe compound in his composition.

Ishigaki teaches a styrene –based thermoplastic resin composition (see Column 7, line 50) with molecular weight within the range of 50000-250000 (see Column 7, line 55), where Fe Stearate and Zn Stearate can be interchangeably used as unblocking agents (see Column 8, line 45 and Column 11, line 15).

Therefore, Zn Stearate and Fe Stearate are art recognized equivalents for such intended use as unblocking agent.

The selection of a known material based on its suitability for its intended use supported a *prima facie* obviousness determination in *Sinclair & Carroll Co. v.*

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Interchemical Corp., 325 U.S. 327, 65 USPQ 297 (1945) , 325 U.S. at 335, 65 USPQ at 301, see also *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960), *Ryco, Inc. v. Ag-Bag Corp.*, 857 F.2d 1418, 8 USPQ2d 1323 (Fed. Cir. 1988) and MPEP 2144.07.

Therefore, it would have been obvious to a person of ordinary skills in the art to use Fe Stearate or Zn Stearate in Voss's composition, since the compounds above are art recognized equivalents for such intended use as unblocking agent.

Response to Arguments

Applicant's arguments filed on 6/23/2008 have been fully considered but they are not persuasive.

Applicant argues that Nonweiler's composition includes non-expandable thermoplastic resin powder.

However, Claim 1 of the Application examined teaches close language (consisting of) only in regard to the beads of expandable vinyl aromatic polymers.

The above thermoplastic resin powder is not a part of the beads, but part of a composition. Therefore, the limitations of the claim 1 are not applicable to the above powder.

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Therefore, rejection based on *Notweiler* or *Bardman* sustains.

Rejections under on 35 USC 102(b) and 103(a) based on *Alvares*, *Ingram*, *Merck Index* and *Niachwiadowicz* are withdrawn due to Amendments to the Claims.

New rejection under 35 USC 103(a) based on *Voss* and *Ishigaki* is added due to Amendments to the claims.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to GREGORY LISTVOYB whose telephone number is (571)272-6105. The examiner can normally be reached on 10am-7pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Rabon Sergent/
Primary Examiner, Art Unit 1796

GL

